

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 38

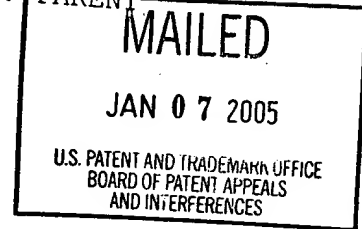
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW E. SUHY and BRENT C. PARENT

Appeal No. 2004-1971
Application No. 09/441,289

ON BRIEF



Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16 and 21-48, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking physical assets. An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced as follows:

16. A method for automatically gathering and analyzing data without human intervention relating to an asset comprising the steps of:

(a) generating a maintenance invoice from an analysis controller when service is performed on the asset, wherein the maintenance invoice includes an indication of the amount of usage of the asset, wherein said indication of the amount of usage is captured by a data acquisition device, and wherein a receiver receives the indication of the amount of usage from the data acquisition device through a transmitter;

(g) transmitting the maintenance invoice on a communication network from the analysis controller to an administrative controller;

(h) comparing on the analysis controller, the indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period; and

(I) generating a warranty report from said administrative controller without said human intervention if the amount of usage is less than the predetermined standard.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

McGuire et al. (McGuire)	4,404,639	Sep. 13, 1983
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999
		(filed Jul. 11, 1997)
Barzilai et al. (Barzilai)	6,012,045	Jan. 4, 2000
		(filed Jul. 1, 1997)
Yamamoto et al. (Yamamoto)	6,141,629	Oct. 31, 2000
		(filed Jul. 13, 1998)

Sager, Business Week, "The Great Equalizer," wysiwyg://19/http://-
www.businessweek.com/1998/35/z3372007/htm (May 18, 1994)

Deierlein, Beverage World, "New Lease on truck life: Automated Maintenance" ISSN: 0098-2318, v113n1566, pp. 138 (May 1994)

Claims 16 and 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire.

Claims 25-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 34, mailed December 12, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 33, filed September 11, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise,

reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse.

We begin with the rejection of claims 16 and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire. We turn first to claim 16. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins &

Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

From our review of the entire record, we note at the outset that the invoice of claim 16 does not have to be written on paper. Rather, the invoice can be displayed on a monitor. From the disclosure of Yamamoto, we find that the computer 21, which displays maintenance information such as the remaining hours until maintenance is due, is a disclosure of generating (on the monitor's display) a maintenance invoice from an analysis controller (computer 21). From the disclosure (col. 11, lines

17-23) that a determination is ordinarily made as to whether or not the user has performed maintenance, such as an overhaul or replacing consumable parts, the data is input into the computer 21, we find that the maintenance "invoice" is displayed on computer 21 when service is performed on the asset. In addition, in Yamamoto, an invoice of information regarding when maintenance is due is displayed on computer 21 when the information is sent to computer 21 by managing computer 51. In addition, as noted by appellants (brief, page 16), Yamamoto is directed to determining when maintenance should be performed, and is not directed to generating a warranty report.

From the teachings of Deierlein of accessing the truck's maintenance history, determining necessary repairs and automatically informing the technician if a repair is covered by warranty, and if so directly billing the supplier for the repair or replacement, we find that Deierlein discloses both determining needed maintenance, as well as whether the repair is covered under a product warranty, and notifying the supplier. In addition, from the disclosure of Nguyen of receiving fault codes and developing a maintenance action log and removal records, as well as a warranty report generator, we find that Nguyen also discloses determining necessary repairs and determining if a

repair is covered under a product warranty, and generating a warranty report. Because Yamamoto is directed to determining when maintenance needs to be performed, we find that an artisan, in view of the teachings of Deierlein and Nguyen, would have been motivated to provide the maintenance time determining system of Yamamoto with a system for additionally determining if a needed repair is covered by a warranty, so that the company can be repaid for the cost of the repairs. However, upon providing Yamamoto with a warranty determination system, we find that the system would be added to managing computer of network 50 of Yamamoto (see figure 12) because network 50 manages and controls the maintenance information (col. 9, lines 5-17) and updates the remaining life of the machines. We find no evidence that an artisan would have been motivated to provide the warranty determination system of Nguyen to computer 21 at monitoring station 20 of worksite 30, because computer 21 is the display location where the user inputs into the system the information as to maintenance that has been performed (col. 11, lines 17-23). Since network 50 is where the maintenance information is managed and controlled, we find that an artisan would have been motivated to add the warranty determination system at managing computer 51 of network 50. However, claim 16 recites that the analysis

controller compares the amount of usage with a predetermined standard representative of the warranty period. As the examiner relies upon elements 20 and 21 of Yamamoto as the analysis controller (answer, pages 9 and 10), we find that even if the prior art were combined as suggested by the examiner, the resultant structure would not meet all of the limitations of the claim as the comparing of usage with warranty terms would be carried out by managing computer 51 of network 50, and not by computer 21 at worksite 30. Accordingly, the rejection of claim 16, and claims 43-48, dependent therefrom, is reversed.

We turn next to the rejection of claims 21-42 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire. The examiner acknowledges (answer, page 7) that Yamamoto does not teach, inter alia, automatic determination of whether or not maintenance has been performed at the analysis controller. The examiner asserts (id.) that it would have been obvious to one of ordinary skill to allow the analysis controller to perform such a function.

From our review of Yamamoto, we find that Yamamoto discloses (col. 8, line 62 through col. 9, line 4) that:

A computer **21** having functions for coordinating the control of the vehicles within the work site **30** is installed in the monitoring station **20**. This computer

21 comprises an input device for inputting information pertaining to maintenance (in-house maintenance) performed by the user in the work site **30** as will be described below, and a display device for displaying, to the user in the work site **30**, maintenance information such as the remaining life until maintenance due time (remaining hours) for each of the plurality of vehicles **10, 11, ...**, at the work site **30**.

From this disclosure of Yamamoto, we find that at computer 21, which the examiner considers to be the claimed analysis controller, information pertaining to maintenance information performed by the user is input by the user. Because the maintenance information is input by the user, we agree with the examiner that Yamamoto does not teach that the analysis controller makes an automatic determination of whether or not maintenance has been performed. Claim 21 recites that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided."

We are not persuaded by the examiner's assertion (answer, page 7) that "[i]t would have been obvious to one of ordinary skill to allow the analysis controller to support such a function" because the analysis controller is linked to the administrative controller. The fact that the computer 21

(analysis controller) and the network 50 (administrative controller) communicate back and forth with each other (col. 9, lines 24-30) is not a teaching of changing input by a user into an automatic determination without human intervention, as required by independent claim 21.

On pages 14 and 15 of the answer, the examiner takes the position that with respect to claim 21, the examiner considers network 50 to be the analysis controller. Irrespective of whether the examiner considers computer 21 or network 50 (having managing computer 51) to be the claimed analysis controller, the fact that the maintenance information is inputted by the user into computer 21 or computer 55 (described, supra) and then transmitted to network 50, does not teach or suggest that the input of information by the user results in the maintenance information being automatically determined, without human intervention, due to the configuration of the analysis controller.

We note the disclosure of Yamamoto (col. 12, line 63 through col. 13, line 3) that when an engine is overhauled at a maintenance plant information to this effect is input by an input device to computer 55 at the maintenance plant, and then input to managing computer 51 via global network 50. From this disclosure

of Yamamoto, we find that input maintenance performed can be input to computer 21 or to computer 55 and then input to managing computer 51. Thus, we find that managing computer 51 does not make an automatic determination, without human input, of maintenance provided. Accordingly, neither computer 21 of monitoring station 20 nor managing computer of network 50 automatically determines, without human intervention, whether maintenance to the asset has been provided. The other references do not make up for this feature missing from Yamamoto. Accordingly, even if we combined the prior art as asserted by the examiner, the resultant combination would not meet all of the limitations of claim 21. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of independent claim 21. The rejection of claim 21, and claims 22-30, dependent therefrom, under 35 U.S.C. § 103(a) is therefore reversed.

We turn next to independent claim 31. We reverse the rejection of claim 31 because claim 31 recites, identically to claim 21, that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided." Accordingly, the

rejection of claim 31, and claims 32-37, dependent therefrom, is reversed.

We turn next to the rejection of claims 38-42. We observe at the outset that appellants do not provide any separate arguments for independent claim 38, and groups claim 38, inter alia, with independent claim 21. In contrast to independent claim 21, which recited that the analysis controller is configured for automatically determining without human intervention whether maintenance of an asset has been performed, claim 38 does not recite that the determination is automatic, or that the determination is done without human intervention. We note the disclosure of Yamamoto (col. 11, lines 17-19) that "[n]ext, a determination is ordinarily made as to whether or not the user has performed maintenance (in-house maintenance)." Yamamoto discloses that after the maintenance information is input, an addition point associated with the type of maintenance is added to the current score of the component (col. 11, lines 24-28). Although this determination is not automatic or done without human input, it is a determination made as a result of the configuration of computer 21. In addition, we find that as shown in figure 12 of Yamamoto, that assets 11, 12, and 13 do not necessarily communicate directly with monitoring station 10, but

rather can communicate through assets 10 and 13. In order to communicate with monitoring station 20 through assets 10 and 13, these assets will inherently contain a controller, to the extent that the controller has been broadly set forth in claim 38. In addition, we note that claim 38 does not recite a comparison related to a predetermined standard representative of a warranty period or the generation of a warranty report as recited in independent claim 16. We are not persuaded by appellants assertion (brief, page 17) that:

the claims of Claim Group B are not obvious because the cited references do not teach all of the claim limitations of Claim Group B. Omissions in the cited art that are discussed below include: (I) an analysis controller located at a second location remote from said local controller; (ii) a data acquisition device to [sic, for] sensing at least one operating characteristic; and (iii) transmitting acquired data from the acquisition device through space to said receiver.

Local controllers 10 and 13 transmit over space to monitoring station 10 which transmits over space "J" to managing and control network 50, including managing computer 51. In addition, assets 11 and 12 have data acquisition devices which transmit information to monitoring station 20 via local controllers 10 and 13. Moreover, controllers 10 and 13 transmit data acquired from acquisition devices on asserts 11 and 12 to monitoring station

20, which transmits the information to network 50. We are not persuaded by appellants' assertion (brief, page 20) that no cited reference discloses an administrative controller separate from said analysis controller because claim 38, unlike independent claim 16, does not recite an administrative controller separate from the analysis controller.

Nor are we persuaded by appellants' assertion that there is no motivation for combining the references. We make reference to our findings, supra, for combining the teachings of Yamamoto and Nguyen. In addition, although claim 38 does not recite the term "warranty," the claim refers to responsible parties which we construe to mean manufacturers whose product(s) are covered by warranties. Upon providing Yamamoto with the warranty determination system of Nguyen, the managing computer 51 would be able to determine if a needed repair was covered by a warranty, and if so, which manufacturer was responsible for the cost of the warranty repair/replacement of an asset or part of an asset. However, although computer 21 may be considered to provide a determination of whether maintenance has been provided (Yamamoto col. 11, lines 17-19) managing computer 51 is not disclosed as making a determination of whether maintenance has been provided. Upon combining the teachings of Yamamoto and Nguyen, the result

would be that the warranty determination system of Nguyen would be provided in the managing computer 51 of network 50. However, claim 38 requires that the analysis controller, in addition to determining whether maintenance of an asset has been provided, also automatically determines which responsible party is responsible for the maintenance performed. Since managing computer 51 would be automatically determining the responsible party, and computer 21 would be determining if maintenance has been provided, the two computers, on separate networks, cannot be considered to be the same analysis controller. The examiner relies upon Barzilai for a disclosure of collation of data to obtain warranty data, and particularly for a teaching of the company who will fulfill and correct the warranty problem. In addition, the examiner relies upon McGuire for a disclosure of automated invoicing.

With respect to Barzilai, we find the reference to be cumulative of the disclosure of Nguyen who discloses a warranty determination system, including the generation of warranty reports, and does not overcome the basic deficiencies of Yamamoto and Nguyen. In addition, as claim 38 does not recite invoicing, we find McGuire to be cumulative to the teachings of Yamamoto, Nguyen and Barzilai. From all of the above, we find that the

CONCLUSION

REVERSED

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